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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/005,696	12/07/2001	Joseph J. Solon	103	7649

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EXAMINER
HAMILTON, ISAAC N

ART UNIT	PAPER NUMBER
3724	

DATE MAILED: 04/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/005,696	SOLON, JOSEPH J.	
	Examiner	Art Unit	
	Isaac N Hamilton	3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 1-18 is/are pending in the application.

4a) Of the above claim(s) 1-9 is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 10-18 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) 10-18 are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 22 January 2002 is/are: a)☐ accepted or b)☒ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 05 .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claim 1-9, drawn to a method of processing tread strips to obtain patterned strips of precise dimension and shape, classified in class 83, subclass 19.

II. Claim10-18, drawn to an apparatus for processing tread strips to obtain patterned strips of precise dimension and shape, classified in class 83, subclass 407.

The inventions are distinct, each from the other because:

2. Inventions I and II are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, another materially different apparatus can practice the process. "Passing the strips" as recited in claim 1, line 5, does not have to be practiced by "grasping" the tread strip by a "power actuated strip feeder means" as recited in claim 10, lines 3-4. The tread strips can be passed through the power actuated strip feeder means by using a pushing means, such as a water jet, moving abutment or retractable robot arm.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with applicant's representative, Mr. Laurence R. Brown, on February 25, 2003 a provisional election was made with traverse to prosecute the invention of Group II, claims 10-18. Affirmation of this election must be made by applicant in replying to this Office action. Claims 1-9 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Drawings

5. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: element 35 in figure 5. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

6. The drawings are objected to because indenting blades 33 appear to be in the wrong place in figure 5. Pages 6 and 7 of the specification recite that the carbide blades 33 are attached to the roller 31, and that the blades 33 process the fabric side of the tire strip, which is facing roller 31. In figure 5 it appears that the carbide blades are attached to roller 30, which contradicts the specification. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

7. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the means for removing tread surface

from the tread strip in claim 18, line 2, must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

8. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

9. The abstract of the disclosure is objected to because it exceeds the 150 word limit.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

10. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

11. Claims 10-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 10 recites the limitation "the length" in line 5. There is insufficient antecedent basis for this limitation in the claim.

Claim 10 recites the limitation "the transit" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 recites the limitation "the strip feeder" in line 6. There is insufficient antecedent basis for this limitation in the claim.

Claim 11 is indefinite due to unclear language, lack of appropriate punctuation and/or erroneous prepositions. This claim should be revised in order to make the limitations clear.

Claim 13 recites the limitation "the timing" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 13 recites the limitation "the shaping step procedures" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 14 recites the limitation "longitudinal edges" in line 4. There is insufficient antecedent basis for this limitation in the claim.

Regarding claim 14, the word "means" is preceded by the word(s) "indentation" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

Claim 15 recites the limitation "the tread" in line 2. There is insufficient antecedent basis for this limitation in the claim.

Claim Rejections - 35 USC § 102

12. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

13. Claims 10-13 and 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Schoendelen (1,578,854).

Regarding claim 10, note power actuated strip feeder means 29; tread strip 26 in figure 3; shorter end is vertical edge in figure 3; linear transit path in figure 1, which starts at 23 and goes to 31, 29, 45 and 65; strip shaping means 49, 51, 22 and 18. It is noted that linear is interpreted to mean "of the first degree with respect to one or more variables" as defined in Merriam-Webster's Collegiate Dictionary, 10th Edition. Since all of the components 23, 31, 29, 45 and 65 are straight edges, they can all be represented with a linear equation of the first degree. It is also noted that the conveyor belt grasps the shorter end of the tread strip through frictional forces.

Regarding claim 11, note slicing means 51 and 49; note tread strips with precisely dimensioned strips with uniform longitudinal strip widths 61 in figure 2.

Regarding claims 12 and 16, note punching means 18 and 22; slicing means 51 and 49.

Regarding claim 13, note mechanism operating said press and said cutting means in timed relation in column 4, lines 84 and 85.

14. Claims 10, 14 and 15 are rejected under 35 U.S.C. 102(b) as being anticipated by Pogrzeba et al. (4,247,273), hereafter Pogrzeba.

Regarding claim 10, note strip feeder means in column 3, lines 67-68; tread strips in figure 3c, the shorter end being the front side in the figure; linear transit path denoted by the arrow adjacent to tread strip 5 in figure1; strip shaping means 1 in figure 3c. Note the power actuated strip feeder means is implied by the statement "material 5 is driven through stamping units" in column 3, lines 67-68.

Regarding claims 14 and 15, note indentation means 1; set of longitudinally spaced indentation patterns 10 in figure 3c. It is noted that the indentation patters 10 can be produced on either side of the tread strip depending on its orientation.

15. Claims 10 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Lundgren (4,833,957).

Regarding claim 10, note power actuated strip feeder means 27, 28; tread strip S, shorter end being the width component; linear transit path indicated by location of S and P in figure 7 moving from right to left; shaping means 46. It is noted that the conveyor belt grasps the shorter end of the tread strip through frictional forces.

Regarding claim 17, note cutting means in column 6, lines 1 and 2; laterally cutting in column 4, lines 26-30; tread strip of precision length in column 3, lines 54-57.

16. Claims 10 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirsch et al (1,744,224), hereafter Hirsch.

Regarding claim 10, note power actuated strip feeder means 35; tread strips 28, shorter end being the width component of 28; linear transit path between pulley 37 and roll 131; strip shaping means 71.

Regarding claim 17, note cutting means 71, which cuts laterally; tread strip of precision length in column 1, lines 23-31.

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

18. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hirsch in view of McMahan (2,866,291). Hirsch discloses everything as noted above, but does not disclose means for removing tread surface. However, Hirsch teaches means for removing tread surface as seen in figure 6. It would have been obvious to provide means for removing tread surface in Hirsch as taught by McMahan in order to remove uneven surfaces on the tread strips and promote accurate cuts by the laterally moving cutter.

Election/Restrictions

19. This application contains claims directed to the following patentably distinct species of the claimed invention:

A. Species in figure 2.

B. Species in figure 5.

20. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic.

21. Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

22. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

23. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Queen, Murphy et al and Pizzorno are cited for similar structure; Bailey and Vargo are cited for punching means; Irie and Perlman are cuted for laterally cutting blades.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Isaac Hamilton whose telephone number is 703-305-4949. The examiner can normally be reached on Monday thru Friday between 8am and 5pm. If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Allan Shoap can be reached on 703-308-1082.

In lieu of mailing, it is encouraged that all formal responses be faxed to 703-872-9302. Any inquiry of a general nature or relating to the status of this application should be directed to the receptionist whose telephone number is 703-308-1148.

IH
March 4, 2003

Allan N. Shoap
Supervisory Patent Examiner
Group 3700